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10/705,257

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Steven K. Lynch

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Joseph W. Berenato, III  
Liniak, Berenato & White, LLC  
6550 Rock Spring Drive, Suite 240  
Bethesda, MD 20817

EXAMINER

GILBERT, WILLIAM V

ART UNIT

PAPER NUMBER

3635

DATE MAILED: 11/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/705,257

Applicant(s)

LYNCH ET AL.

Examiner

William V. Gilbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 47-49 and 51-54 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50 is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-25 and 27-46 is/are rejected.
- 7) ☒ Claim(s) 16, 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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#### **DETAILED ACTION**

This is a First Action on the Merits in response to Applicant's election of invention dated 31 August 2006. Claims 1-46 and 50 are pending below. Claims 47-49 and 51-54 are withdrawn from consideration.

#### ***Election/Restrictions***

1. Applicant's election with traverse of Claims 1-46 and 50 in the reply filed on 31 August 2006 is acknowledged. The traversal is on the ground(s) that the search would not be a serious burden on the Examiner. This is not found persuasive because while invention II is in a class 52, it would require a burdensome search in numerous subclasses within class 52. Invention II would not be searched in the same subclasses as Invention I (see Restriction).

The requirement is still deemed proper and is therefore made FINAL.

Claims 47-49 and 51-54 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 31 August 2006.

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***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

***Specification***

3. The disclosure is objected to because of the following informalities: Applicant claims priority of Application 10/361592 (page 2, line 6), but this number seems to be in error. Examiner believes Applicant intended to print "10/351592".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 (page 31, line 15), 17, 19, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 16 and 17, Applicant has two Claim 16's (see Page 31). Claim 17 depends from Claim 16. The Examiner did not consider the second Claim 16 or Claim 17.

Regarding Claims 19, 20 and 21 (page 32) each depends from itself (e.g. line 09: 19. The door skin of claim 19). None of these claims were examined.

Claim 28 recites the limitation "said printed layer" in Claim 28, line 2. There is insufficient antecedent basis for this limitation in the claim.

#### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not

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identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12, 18-24, 29-43 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-34 respectively of copending Application No. 10351592 ('592). Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 1-12, 18-24 and 29-43 read substantially similar to Claims 1-34 respectively of the '592 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13, 14, 15, 18, 22, 23, 25, 29, 30, 32-43 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Gartland (U.S. Patent No. 5,540,266).

Regarding Claim 1, Gartland discloses a door skin comprising an exterior and interior side, first and second molded styles (Figure 7, element 12) on a first plane, a flat planar portion (25) between the stiles (12) on a second plane (Figure 4) and a first interface portion (27).

Regarding Claim 2, Gartland discloses rails (15, 26) on a third plane intermediate the first and second planes (the rails are between the styles and planar portion and therefore are intermediate the first and second planes).

Regarding Claim 3, edge portions (28) between the stiles and rails.

Regarding Claim 4, the edge portions extend angularly from the styles to the rails (28).

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Regarding Claim 5, a second interface (27) between the rails and flat planar portion.

Regarding Claims 6 and 22, the second interface extends angularly from the rails to the flat planar portion.

Regarding Claims 7 and 18, a decorative layer (Figure 7) secured to the exterior side.

Regarding Claim 8, the decorative layer is veneer (Abstract, line 10).

Regarding Claim 9, the pattern is decorative (Figure 7).

Regarding Claim 10, the decorative pattern is wood grain.

Regarding Claim 11, the wood grain pattern is parallel to the stiles (12) and perpendicular to the rails (15).

Regarding Claim 13, a veneer panel covers the rails. The statement "inserted" is a method of making the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding Claims 14 and 25, the decorative layer is in a substrate (veneer). The statement "is applied" is a method of making the claimed invention and must result in a structural difference between the claimed invention and the prior art in



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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Regarding Claim 15, the skin has a second interface (27) between the rails and planar portion and a third interface (27) between the stiles and rails.

Regarding Claim 23, the interface portion has a curved portion (see Figure).

Regarding Claim 29, the prior art discloses a door with a peripheral frame and first and second door skins (Column 11, lines 27-32), having first and second molded styles (Figure 7, element 12) on a first plane, rails (15, 26) on a second plane intermediate the first and third planes (the rails are between the styles and planar portion and therefore are intermediate the first and third planes), a flat planar portion (25) between the stiles (12) on a third plane (Figure 4), a first interface portion (27), a second interface (27) between the rails and flat planar portion, and edge portions (28) between the rails and styles.

Regarding Claim 30, the second plane is intermediate the first and third planes (see rejection of Claim 29 for explanation).

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Regarding Claim 32, a first decorative layer is secured to the exterior side (see Figure 7).

Regarding Claim 33, the first decorative layer is veneer.

Regarding Claim 34, the decorative layer has a pattern (see Figure 7).

Regarding Claim 35, the pattern is wood grain (see Figure 7).

Regarding Claim 36, the wood grain pattern runs parallel to the stiles (see Figure 7).

Regarding Claim 37, a second decorative layer is secured to the first decorative layer covering the rails (Figure 8, element 54).

Regarding Claim 38, the second decorative layer (54) does not extend above the plane of the first layer covering the stiles (31).

Regarding Claim 39, the second decorative layer is veneer (Abstract).

Regarding Claim 40 the second decorative pattern is wood grain (Figure 7).

Regarding Claim 41, the wood grain pattern runs parallel with the rails (26).

Regarding Claim 42, the edge portions (28) extend angularly from the stiles to the rails.

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Regarding Claim 43, the second interface portion (27) extends angularly from the rails (31) to the flat planar portion (25).

Regarding Claim 46, the prior art discloses a door comprising a peripheral frame, the prior art discloses a door with a peripheral frame and first and second door skins (Column 11, lines 27-32), stiles (Figure 7, element 12) on a first plane, a planar portion (25) between the stiles (12) on a plane spaced from the plane of the stiles, and rails (15, 26) secured to the planar portion at opposite ends.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 24 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer.

Regarding Claims 12 and 31, the prior art discloses the claimed invention except that the rails are recessed from the

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stiles from between 0.1 millimeters to about 0.6 millimeters.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these limitations because Applicant failed to disclose a criticality for the necessity of these limitations and the prior art is capable of being made in such a fashion.

Regarding Claim 24, the prior art discloses the claimed invention except that the flat planar portion is recessed from the stiles from between about 3 millimeters to about 11 millimeters. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have these limitations because Applicant failed to disclose a criticality for the necessity of these limitations and the prior art is capable of being made in such a fashion.

**Claims 27, 28, 44 and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer in view of Reinemer (U.S. Patent No. 2,692,450)

Regarding Claims 27, 28, 44 and 45, Bauer discloses the claimed invention except for the use of transfer foil on the veneer. Reinemer discloses using veneer with a transfer foil to create various graphic designs (Column 4, line 69 to Column 5,

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line 10). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use the transfer foil on the door in Bauer because it would add a protective coating to the door while making the door aesthetically pleasing. Further, per Claims 44 and 45 the prior art does not disclose that the transfer foil is transparent. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the foil as transparent because the coloring of the foil provides only aesthetic limitations, not structural. Making the foil clear would permit the underlying layer to be seen unobstructed while providing a protective coating.

***Allowable Subject Matter***

8. Claims 16 (page 31, line 10) and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 50 is allowed.

Regarding the above claims, the prior art of record fails to disclose cracks in the decorative coating.

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**Conclusion**

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Turner (U.S. Patent No. 4,702,054); Liittschwager (U.S. Patent No. 6,485,800).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Naoko Slack can be reached on 571.272.6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WVG  
06 Nov 2006

Basil Kettle  
BASIL KETTLE  
PAIR/PAIR

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